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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,229	06/25/2004	Raimund Kram	03869-105012	7455

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KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-4003

EXAMINER

HARTMAN JR, RONALD D

ART UNIT	PAPER NUMBER
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2121

NOTIFICATION DATE	DELIVERY MODE
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11/19/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptomailnyc@kslaw.com

Office Action Summary	Application No. 10/500,229	Applicant(s) KRAM ET AL.	
	Examiner RONALD D. HARTMAN JR	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Upon further consideration, and in light of the International Search Report issued on PCT/DE02/04744, which was mailed on 8/7/2003, the examiner believes that the instant claims are restrictable, as this is further explained below in this office action.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 22, drawn to a method of automation movement control utilizing unit less profiles.

Group II, claim(s) 23-44, drawn to a system and method for automation movement control utilizing functions of a higher degree.

Group III, claim 45, drawn to an automation system.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

- With respect to independent claim 22, independent claims 23, 44 and 45 do not require unit less profiles, among others.

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- With respect to independent claims 23, 33 and 44, independent claims 22 and independent claim 45 do not require functions of a higher degree, among others.
- With respect to independent claim 45, independent claim 22 does not require controlling an axis, among others.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Examiner Notes

Since the examiner has already provided an office action before issuing this restriction requirement, the examiner would like to take this opportunity to point out several deficiencies that the applicant should address when formulating a response to the this restriction requirement.

Claims 22-44 will be rejected under 35 U.S.C. 101 in their current form.

With regards to claim 22, the proper test for a patent-eligible process is:

- a) the process must transform subject matter to a different state or thing; OR
- b) the process must be implemented via a specific machine.

It is noted that a general purpose computer does not appear to rise to the level of a specific machine, per se.

That being said, claim 22 does not require specific machine implementation, nor does the claim require a transformation of subject matter.

With regards to claim 23, the applicant claims a system comprised of a profile. The profile is viewed to be representative of descriptive material, per se, and therefore the claimed system merely amounts to a system of non functional descriptive material. As per MPEP 2106.01, "When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement."

Claim 23 simply requires no function to be performed. Intended use of a claim or feature may not be relied upon to overcome rejections formed under 35 U.S.C. 101.

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With regards to pending claim 33, the same rational (as applied to claim 22 above) is applied herein.

With regards to pending claim 44, the same rational (as applied to claim 23 above) is applied herein.

Further, pending claim 22 would be rejected under 35 U.S.C. 112 2nd as being interpreted to having antecedent basis problems. The applicant first recites that the claim requires the providing of **either** argument **or** function variables, but then requires there to be a distinction between these two variables. If the claim is interpreted to only include argument variables or only function variables, there is not proper antecedent basis for the function variables or argument variables, respectively, since only one type of variable is actually positively recited, not both.

Further, with regards to pending claim 44, this claims a system with the entire claim being devoted to the intended use associated with an intended use of creating a profile, wherein the profile itself is then discussed in some detail. Due to the choice of claim construction for this particular claim, this claim may simply condense to “An engineering system.” since the intended use of the system, and limitations derived therefrom, do not serve to limit the claim. That being said, since the intended use is not relied upon, the applicant has not provided an actual system since there are no parts actually claimed, there is merely an assertion of an engineering system. Further, clearly an engineering system is not novel since engineering, and tools formed therefrom, have been around for thousands of years.

The applicant is strongly encouraged to amend the claims to overcome the shortcomings listed above when formulating the response to the restriction requirement formed herein.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RONALD D. HARTMAN JR whose telephone number is (571)272-3684. The examiner can normally be reached on Mon.-Fri., 11:00 - 8:30 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald D Hartman Jr./

Examiner, Art Unit 2121

November 16, 2008

RDH